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10/579,046

05/09/2006

Minerva M. Yeung

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EXAMINER

FANG, PAKEE

ART UNIT

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4146

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/579,046 | Applicant(s) YEUNG ET AL. | |
| | Examiner PAKEE FANG | Art Unit 4146 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/09/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2008; 06/07/2006; 05/09/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1 - 18 are presented for examination.**

Priority

2. Acknowledgment is made of applicant's claim for foreign priority & domestic priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the application filed on 05/09/2006.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 10/14/2008; 06/07/2006; & 05/09/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 518 (Figure 5), 910 and 914 (Figure 9).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 - 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter: The recitation of the claim 7 recites "An article; comprising a storage medium having a plurality of machine accessible instructions" and the applicant stated "machine accessible instruction" could be a carrier wave [0052] in the specification therefore, the claims are non- statutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 5 – 7, 9, 11 - 13 & 15 – 18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Ohara et al. (US Pat. 5739814).

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In regard to claim 1, Ohara (col. 2 Ln. 53 to col.3 Ln. 24) discloses a method of associating a selected object on any printed material to a valid response provided by a computer system comprising;

determining a position on a page of the printed material; (col. 3 Ln. 14 – 31 & col. 4. Ln. 17-31; fig. 1 & fig. 9)

transmitting the position to the computer system; (col. 3 Ln. 14 – 31 & col. 4. Ln. 63 - 68; fig. 2)

correlating the position to selected content associated with the printed materials, the selected content being accessible by the computer system; (col. 6 Ln. 46 – 49 & col. 4 Ln. 17 – 31; fig. 1 & 9)

and providing a valid response to a user based at least in part on the position and the correlated content, wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system. (col. 6 Ln. 46 – 49 & col. 5 Ln. 27 – 59; fig. 1 & 9)

In regard to claim 3, wherein correlating the position comprises searching a printed material database, the printed material database comprising positional information of objects on the pages. (col. 3 Ln. 14 -39 & col. 4 Ln. 26 – 29; fig. 1)

In regard to claim 5, wherein performing the action comprises at least one of adjusting volume of a speaker, adjusting brightness of a computer monitor, sending commands to an input/output (I/O) port, and powering off the computer system. (col. 5 Ln. 17 – 25 & col. 5 Ln. 27 – 45; fig. 3) – I/O port is the terminal (Item 12) to retrieve and load information from the book to the computer, and vice-versa.

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In regard to claim 6, wherein the printed material comprises a traditional paper book.

(col. 6 -61 – col. 7 Ln. 10; fig. 7 - 8)

In regard to claim 7, Ohara (col. 2 Ln. 53 to col.3 Ln. 24) discloses an article comprising: a storage medium having a plurality of machine accessible instructions, (col. 4 Ln. 26; fig. 1)

wherein when the instructions are executed by a processor, the instructions provide for associating a selected object on any printed material to a valid response provided by a computer system by determining a position on a page of the printed material; (col. 3 Ln. 14 – 31 & col. 4 Ln. 26-29; fig. 1)

transmitting the position to the computer system; (col. 3 Ln. 14 – 31 & col. 4. Ln. 63 - 68; fig. 2)

correlating the position to selected content associated with the printed materials, the selected content being accessible by the computer system; (col. 6 Ln. 46 – 49 & col. 4 Ln. 17 – 31; fig. 1 & 9)

and providing a valid response to a user based at least in part on the position and the correlated content, wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system. (col. 6 Ln. 46 – 49 & col. 5 Ln. 27 – 59; fig. 1 & 9)

In regard to claim 9, wherein instructions for correlating the position comprise instructions for searching a printed material database, the printed material database comprising positional information of objects on the pages. (col. 3 Ln. 14 -39 & col. 4 Ln. 26 – 29; fig. 1)

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In regard to claim 11, wherein the action comprises at least one of adjusting volume of a speaker, adjusting brightness of a computer monitor, sending commands to an input/output (I/O) port, and powering off the computer system. (col. 5 Ln. 17 – 25 & col. 5 Ln. 27 – 45; fig. 3) – I/O port is the terminal (Item 12) to retrieve and load information from the book to the computer, and vice-versa.

In regard to claim 12, Ohara (col. 2 Ln. 53 to col.3 Ln. 24) discloses a system for associating a selected object on any printed material to a valid response provided by a computer system comprising:

a pointing device to determine a position on the printed material; (fig. 5 & 9, item 24)

a communicating device to transmit the position to the computer system; (col. 3 Ln. 14 – 31 & col. 4. Ln. 63 - 68; fig. 1 & 2, item 6)

a player component to correlate the position to selected content associated with the printed materials, the selected content being accessible by the computer system; (col. 6 Ln. 46 – 49 & col. 4 Ln. 17 – 31; fig. 1 & 9 item 18)

and to provide a valid response to a user based at least in part on the position and the correlated content, (col. 6 Ln. 46 – 49 & col. 5 Ln. 27 – 59; fig. 1 & 9)

wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system. (Col. 5 Ln. 27 -65)

In regard to claim 13, wherein the pointing device comprises an electronic pen. (fig. 5 & 9, item 24)

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In regard to claim 14, further comprising a holder structure to hold the printed materials in a fixed relationship to the pointing device. (col. 6 Ln. 5 – 17 & fig. 5 & 9, item 24)

In regard to claim 15, further comprising a multimedia database to store digital multimedia content, (col. 2 Ln. 53 to col.3 Ln. 24; fig. 9) a printed material content database to store positional information about objects on the pages and linkage information between the objects and at least one of the multimedia contents and actions, and an action library to store directives for actions to be performed on the system. (col. 5 Ln. 27 -65, fig.3)

In regard to claim 16, wherein the printed material comprises a traditional paper book. (col. 6 -61 – col. 7 Ln. 10; fig. 7 - 8)

In regard to claim 18, wherein the action comprises at least one of adjusting volume of a speaker, adjusting brightness of a computer monitor, sending commands to an input/output (I/O) port, and powering off the computer system. (col. 5 Ln. 17 – 25 & col. 5 Ln. 27 – 45; fig. 3) – I/O port is the terminal (Item 12) to retrieve and load information from the book to the computer, and vice-versa.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al. (US Pat. 5739814) in view of Wood et al. (US Pat. 6414673 B1)

Ohara discloses on Claims 1, & 7 all the limitations which claims 2 & 8 depended on.

In regard to claims 2 & 8, wherein instructions for determining the position comprise instructions for detecting ultrasound signal timing information generated by an electronic pen situated near the printed material. Ohara discloses a printed material on a book situated near an electronic pen (col. 7. line 52 - 61 fig. 9), but Ohara fails to disclose an ultrasound signals timing information. However, Wood discloses a method for ultrasound signal timing information along with ultrasound sensors near a moving pen on a material being printed (Col. 13 Ln. 14 – 22; Figs. 9 & 17). Since, Ohara and Wood inventions are both analogous arts addressing Pen input system. Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to combine the input system of Ohara, with the ultrasound signal timing information provide by the ultrasound sensors near a moving pen of Wood to improve the accuracy for the position of the moving pen and also to provide “a means for communicating supplementary information between a transmitter pen and external receivers...” (Wood; col. 2 Ln. 59 – 63)

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Claims 4, 10, & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al. (US Pat. 5739814) in view of Amano et al. (US Pub. 20040119696 A1).

Ohara discloses on Claims 1, 7 & 12 all the limitations which claims 4, 10, & 14 depended on.

In regard to claims 4, 10, & 14 wherein performing the action comprises selecting a language to be used for subsequent responses. Ohara discloses an electronic book which is use in devices for entertainment, learning, and others with selectable feature on the screen. (col. 2. line 30 -42; fig. 3 & 9), but Ohara fails to disclose a language selection feature to be used for responses of the system. However, Amano discloses a language selection feature use for responses for the input of the user on figs. 13 & 14 ([0048 – 0052]) Since, Ohara and Amano inventions are both analogous arts addressing multi-purpose input system. Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to combine the learning input system of Ohara with the language selection feature of Amano to improve the learning experience of all users with a different cultural/lingual background.

Conclusion

Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bryborn at el. (US Pub. 20030122802) & Ogawa (US Pub. 20010050669).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAKEE FANG whose telephone number is (571)270-7219. The examiner can normally be reached on Monday-Friday 9AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patel Ramesh can be reached on (571)272-3688. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PAKEE FANG/

Examiner, Art Unit 4146

/Ramesh B. Patel/

Supervisory Patent Examiner, Art Unit 4146